

REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, pursuant to and consistent with 37 C.F.R. § 1.112, and in light of the remarks which follow.

Applicants thank the Examiner for acknowledging the claim for foreign priority under 35 U.S.C. § 119 and for indicating that all certified copies of the priority documents have been received. Additionally, Applicants thank the Examiner for the Examiner-initialed copies of Applicants' PTO Forms 1449, which Applicants submitted with their First and Second Information Disclosure Statements on June 6, 2005, and January 25, 2007, respectively. Finally, Applicants thank the Examiner for indicating that Claims 4 and 9-11 would be allowable if rewritten to overcome the claim objections and to include all of the elements of the base and intervening claims. In view of the foregoing amendments and following remarks, Applicants respectfully submit that all pending claims are in condition for allowance.

Claims 1-15 and 18-23 are pending the application, new claim 23 having been added above.

By the above amendments, Applicants amended the claims by replacing "alkyl" with --alkylene-- and "aryl" with --arylene--, as suggested by the Official Action. Applicants also rewrote Claims 4 and 9 in independent form in view of the Official Action's indication that these claims are patentable over the prior art. Applicants also made other minor amendments to the claims to put them into a more conventional U.S. Patent format. A claim that has been amended in a manner that does not narrow the claim's scope should be accorded its full range of equivalents.

Finally, Applicants added new claim 23 to further define exemplary embodiments.

Support for new claim 23 can be found at least in the original claims.

Turning now to the Official Action, Claims 1 and 9 and their respective dependent claims stand objected to for including various informalities. In particular, the Official Action suggested replacing "alkyl" and "aryl" with --alkylene-- and --arylene--, respectively, in the definition of group "R."

To obviate the objection, Applicants amended the claims where appropriate, as suggested by the Official Action. Should additional clarifying amendments be desirable, Applicants would be pleased to consider any further suggestions the Examiner may have. Reconsideration and withdrawal of the claim objection are respectfully requested.

Claim 13 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. For at least the reasons that follow, withdrawal of the rejection is in order.

The Official Action rejects Claim 13 for use the term "binary." In view of Applicants' amendments to Claim 13, including deletion of "binary," Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 1-3, 5-8, 12-15 and 18-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over King (U.S. Patent No. 5,696,210) in view of Hasselhorst (U.S. Patent No. 6,346,562). For at least the reasons that follow, withdrawal of the rejection is in order.

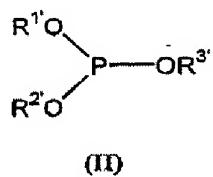
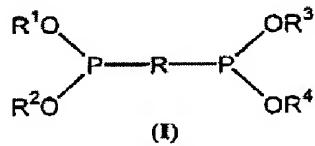
Claim 1, as amended above, defines an adhesive silicone elastomer composition which can be crosslinked under hot conditions by polyaddition (hydrosilylation), this composition being of the type of those comprising:

- ♦ ◆ a/ at least one PolyOrganoSiloxane (POS) carrying ethylenic and/or

acetylenic unsaturation(s) {POS comprising \equiv Si-[unsaturation] units};

- ◆ β / at least one polyorganosiloxane (POS) carrying \equiv Si-H units;
- ◆ γ / a catalytic combination comprising:
 - ~ $\gamma.1$ at least one metal catalyst
 - ~ $\gamma.2$ and at least one crosslinking inhibitor;
- ◆ δ / a filler;
- ◆ ϵ / at least one adhesion promoter;
- ◆ ρ / at least one POS resin;
- ◆ λ / at least one agent for stability toward heat;
- ◆ ϕ / optionally at least one other functional additive;

said composition being a single-component composition wherein the crosslinking inhibitor $\gamma.2$ is selected from the group of compounds of following formula (I) or (II):



in which:

R , R^1 , R^2 , R^3 , R^4 , $R^{1'}$, $R^{2'}$ and $R^{3'}$, which are identical or different, represent a linear, branched or cyclic alkylene radical or a substituted or unsubstituted alkylene radical, in particular:

- i. a linear or branched alkylene radical having in particular from 2 to 30 carbon atoms (C),
- ii. an alkylene radical comprising one or more rings, in particular 1 or 2, it being possible for a ring to have in particular from 4 to 14 C, or
- iii. an alkylene or alkylarylene radical comprising one or more fused or nonfused aromatic rings, in particular 1 or 2 rings, it being possible for a ring to comprise from 4 to 14 C, optionally substituted by 1 or more, in particular from 1 to 2, linear or branched alkylene(s) having in particular from 1 to 12 C.

(Emphasis added.)

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claimed features. (See, *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).) In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." (See, *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).) (See, also M.P.E.P. § 2143.03).

King relates to a solventless, addition-curable silicone adhesive composition that is flowable or extrudable at room temperature. The compositions of King first cure to a viscous, tacky state which have a high green strength but still allow adjustment or replacement of the adherends (i.e., a pressure sensitive adhesive), and thereafter slowly cure to yield a high strength, immovable bond (i.e., a permanent adhesive). (See King at column 1, lines 1-11.)

Haselhorst relates to crosslinkable mixtures, a process for preparing them and their use. (See Haselhorst at column 1, lines 5-6.)

The Official Action admits at page 3 that King fails to disclose or fairly suggest a phosphite compound adhering to any of the structural formulae provided in the instant claim. The Official Action relies on Haselhorst to overcome the deficiencies of King. However, Applicants submit that Haselhorst also fails to disclose the claimed compounds. Instead, it appears to Applicants that the Official Action has relied upon the general disclosure of Haselhorst to support the position that it would have been obvious to arrive at the claimed compounds. Applicants respectfully disagree.

First, the Applicants respectfully submit that the asserted combination of King and Haselhorst does not establish a *prima facie* case of obviousness because neither of the references, alone or in combination, disclose or fairly suggest each feature in the combination of features defined in independent claim 1.

In addition, Applicants submit that the Official Action does not establish a *prima facie* case of obviousness under § 103 because the Official Action does not provide sufficient reasons to demonstrate *why* one of ordinary skill in the art would have been led to modify King with Haselhorst to arrive at the claimed adhesive silicone elastomer composition. The requisite motivation for doing so must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art, not from Applicants' disclosure. (See, *Ex Parte Nesbitt*, 25 U.S.P.Q. 2d 1817, 1819 (B.P.A.I. 1992); and *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1446 (Fed. Cir. 1992).) The mere fact that the prior art can be modified does not make such a modification obvious unless the prior art or some other evidence specifically suggests the desirability of the modification. (See, *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).) There must be some intrinsic basis in the prior art or some extrinsic factor that would prompt one of

ordinary skill in the art to combine the teachings of the references; otherwise, the Patent Office's burden of establishing a *prima facie* case of obviousness has not been met.

Moreover, the determination of whether some reason, suggestion or motivation existed for making the combination must be made from the viewpoint of a hypothetical person of ordinary skill in the field of the invention. (See *In re Oetiker*, 24 U.S.P.Q. 2d 1446; and *In re Raines*, 28 U.S.P.Q. 2d 1630, 1631 (Fed. Cir. 1993).) In the present case, no such factors or motivation for combining or modifying King and Haselhorst exist. Indeed, Applicants submit that Haselhorst is not even directed to adhesive silicone elastomer compositions. Further, Haselhorst is completely silent regarding solutions or approaches for providing adhesive silicone elastomer compositions that can be easily formed and can exhibit an ability to retain form once fashioned for at least a period of time long enough to achieve crosslinking. As far as Applicants can tell, Haselhorst is completely silent regarding rheological issues encountered in the field of adhesive compositions, let alone any strategies for dealing with such problems.

In view of the deficiencies in King and the failure of Haselhorst to provide any suggestion that one should, or even could, select specific technical features of Haselhorst to be used to modify the compositions of King to arrive at the claimed subject matter, Applicants submit that the Official Action has not demonstrated that one of ordinary skill in the art would have been motivated to combine the references to obtain the claimed combinations of features. Accordingly, Applicants submit that there is no basis, absent impermissible use of hindsight based on Applicants' disclosure, for combining the references as suggested by the Official Action.

The Official Action has failed to show any motivation for one of ordinary skill in the art to have looked to the varying teachings of the references and combined those teachings to obtain the claimed subject matter. Clearly, the motivation for doing so can only come from the teachings of the present specification, which discloses the desirability of the claimed adhesive silicone elastomer compositions to promote rheological properties suitable for industrial applications such as, for example, adhesive bonding, which can make the compositions convenient for handling and economical. However, the motivation for combining cited references cannot come from Applicants' invention itself. (See *In re Oetiker*, 977 F.2d 1443, U.S.P.Q. 2d 1443 (Fed. Cir. 1992).) That is, the motivation for combining the references cannot be a product of hindsight reconstruction of the claimed invention based on Applicants' own disclosure.

It appears that such a hindsight reconstruction has been made in the Official Action because the Official Action asserts that the claimed adhesive silicone elastomer compositions would have been obvious based on a hindsight selection of claimed features. Such a combination is improper because the references, viewed by themselves and not in retrospect, must teach the combination asserted by the Official Action. (See *In re Schaffer*, 229 F.2d 476, 108 U.S.P.Q. 326 (C.C.P.A. 1956); and *In re Stoll*, 523 F.2d 1392, 187 U.S.P.Q. 481 (C.C.P.A. 1975).) Here, the references do not provide any motivation for combining different elements and/or modifying the disclosed compositions to obtain the presently claimed subject matter. The only motivation for doing so derives from the disclosure of Applicants' application, which is improper.

The Official Action also fails to establish that the prior art provides a reasonable expectation of success. M.P.E.P. § 2143.02 states that a reasonable expectation of success is required to establish a *prima facie* case of obviousness. That is, beyond looking to the prior art to determine if it suggests doing what the inventors have done, one must also consider if the art provides the required expectation of succeeding in that endeavor. (See *In re Dow Chem. Co. v. American Cyanamid*, 837 F.2d at 473, 5 U.S.P.Q. 2d at 1531 (both the suggestion and the expectation of success must be found in the prior art not in Applicant's disclosure.)) In this case, however, the asserted combination of references provides neither a suggestion or an expectation of success in doing what the inventors have done (i.e., obtaining adhesive silicone elastomer compositions capable of exhibiting rheological properties suitable for industrial application). Specifically, there is no evidence in the prior art references or elsewhere to demonstrate that one would have expected to have obtained the claimed compositions by modifying the compositions of King based on the disclosure of King by itself or combination with Haselhorst.

For at least these reasons, Claim 1 is patentable over King, alone or in combination with Haselhorst. Because the remaining claims (Claims 2-3, 5-8, 12-15 and 18-22) depend, directly or indirectly, from independent claim 1, the remaining claims are also patentable over King, alone or in combination with Haselhorst for at least the reasons that Claim 1 is patentable. Reconsideration and withdrawal of the § 103(a) rejection over King in view of Haselhorst are respectfully requested.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

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